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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,980	02/09/2004	Elizabeth M. Doherty	A-824	1288

7590 11/24/2006

U.S. Patent Operations/RVP
Dept. 4300, M/S 27-4-A
AMGEN INC.
One Amgen Center Drive
Thousand Oaks, CA 91320-1799

EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,980

Applicant(s)

DOHERTY ET AL.

Examiner

Celia Chang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,8-10 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8-10, 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Amendment and response filed by applicants dated Jun. 6, 2006 have been entered and considered carefully.

Claims 1, 6, 8-10, 14-20 being drawn to group I are pending.

2. The rejection of claims 1, 6, 9, 14, 17 under 35 USC 102(e) over US '746 or US '223 are dropped in view of that compound 559 '746 or 33'223 are position isomer and the R4 position is not hydrogen.

3. The rejections of claims 1, 6, 8-10, 14-20 over Das '746 or Hynes '223 under 35 USC 103(a) are maintained for reason of record.

Even if the species as delineated are position isomer instead of anticipatory compounds, i.e. since X2 and X3 are CR8 and CR9 wherein R8 and R9 are optionally hydrogen, thus, the delineated compounds 559 of '746 or 33 or '223 are "position isomers" that is the R4 nonhydrogen moiety is at ortho or meta position of the amide bond linker. Position isomers have been clearly explained in the previous office action are prima facie obvious since the references clearly and comprehensively taught such variation with ample of examples enabling such modification.

Further, applicants argument that cycloalkyl is not within the claims is erroneous. Applicants' attention is drawn to p.11 of the specification wherein the alkyl of the instant claims have been explicitly denoted to include cyclical relationship, thus, cyclopropyl.

The rational for finding "compounds" being prima facie structural obvious is based on the modification was comprehensively described and enabled for the utility of prior art references. It is immaterial that applicants' compounds may have a different utility from that of the prior art. Arguments regarding utility must be based on a meaningful showing of an unexpected difference in properties of applicants compound versus the compounds of the prior art. In re Hoch 166 USPQ 406, In re Payne 203 USPQ 247.

Absent of a showing of unexpected results, mere argument that prior art compounds which are position isomers of the claims have different utility does not obviate the rejection.

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Position isomerism have been known to be useful tool for obtaining new and useful drugs, Ex Parte Engelhardt 208 USPQ 343.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

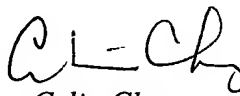
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie, Ph. D., can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Nov. 17, 2006


Celia Chang
Primary Examiner
Art Unit 1625